

**REMARKS**

Applicants have thoroughly considered the Examiner's remarks in the final Office action dated July 25, 2007. The claims have been restructured to place the claims in condition for allowance or appeal. The claims have been also amended to materially reduce or simplify the issues for appeal. Claims 2, 7, 16, and 19 have been amended and claims 14, 17, 18, and 20 have been canceled by this Amendment D. Claims 1, 2, 4-13, 16, and 19 thus remain pending. Applicants respectfully request allowance in view of the amendments and remarks herein.

**Claims Improperly Rejected**

Applicants submit that the Examiner appears to have improperly relied on U.S. Patent Publ. No. 2004/0107137 to Skinner ("Skinner"). Skinner has a filing date of July 21, 2003, and is a continuation-in-part of an application filed on December 2, 2002 that claims priority from a provisional application filed November 30, 2001. The "prior art date of a U.S. patent issued from a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application for subject matter that is disclosed in the provisional application." MPEP 901.04 (emphasis added). Thus, Skinner has an effective date of November 30, 2001 only for subject matter that is disclosed in the provisional application.

It appears that the subject matter of Skinner relied upon by the Examiner in rejecting claims 1, 2, 4, 7, 8, 9-14, and 16-20 **does not appear within the provisional application**. For example, the "tracking engine" for tracking user access to a banner, and the purchase of advertiser space on host pages does not appear to be included in the provisional application, among other features relied on by the Examiner.

Thus, the subject matter of Skinner relied upon by the Examiner in rejecting the claims has an effective date of either December 2, 2002 or July 21, 2003. Both of these dates are after the December 31, 2001 filing date of the present application. Accordingly, the subject matter of Skinner relied upon by the Examiner must be removed from consideration, and the rejection of claims 1, 2, 4, 7, 8, 9-14, and 16-20 in view of this subject matter must be withdrawn. Should the Examiner maintain the rejection, erroneously we believe, Applicants request that the Examiner identify the applicable portions of the provisional application to which Skinner claims priority to support the Examiner's claim rejections.

Thus, Applicants submit that the rejections of claims 1, 2, 4, 7, 8, 9-14, and 16-20 in view of Skinner is improper.

#### **Combination of Narin with Thomas is Improper**

Applicants submit that the Examiner has improperly combined U.S. Patent Publ. No. 2002/0046045 to Narin et al. ("Narin") with U.S. Patent No. 6,401,118 to Thomas ("Thomas") to reject pending claims 1, 2, 4-13, 16, and 19.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01 quoting *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Combining Narin with Thomas creates a combination that renders Thomas unsatisfactory for its intended purpose. In particular, the purpose of Thomas is to search numerous sites on the Internet for URLs linking to identify content that violates intellectual property. Narin discloses a shopping architecture that makes a limited, predetermined set of retailers available to a user for shopping. Combining Narin with Thomas produces a

system that only searches a limited, predetermined set of sites. Thus, the system of Thomas modified by Narin would never discover any new URLs linking to offending content. This effectively renders Thomas unsatisfactory for its intended purpose.

Further, "it is improper to combine references where the references teach away from their combination." MPEP 2145 quoting *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). As noted above, Narin discloses a shopping architecture that makes a limited, predetermined set of retailers available to a user for shopping. Thomas teaches a system for searching the Internet (e.g., a undetermined set of content). Thus, Narin and Thomas teach away from their combination.

Accordingly, Applicants submit that it is improper to combine Narin with Thomas, and thus submit that the rejection of claims 1, 2, 4-13, 16, and 19 should be removed for at least this reason.

#### **Improper Hindsight Analysis**

Further, Applicants submit that the Examiner has relied on improper hindsight to pick and choose:

- five (5) references to reject claim 4;
- five (5) references to reject claim 6;
- four (4) references to reject claim 5;
- four (4) references to reject claim 2;
- four (4) references to reject claim 9; and
- three (3) references to reject claims 1, 7, 8, 10-14, and 16-20.

Applicants submit that the Examiner has failed to **articulate the reasons** for combining each of the applied references in rejecting the claims as set forth above.

"[R]ejections on obviousness grounds cannot be sustained by mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR Int’l Co. v. Teleflex Inc., 550 U.S. \_\_\_\_ (2007) quoting In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006). Applicants request that the Examiner clearly identify a rational underpinning to the obviousness rejections of the claims that links all of the references for each of the rejections, or remove the rejections.

In addition, the applied references solve different problems, and have different solutions. Coleman is directed to an interactive product selector. Knapp is directed to a system for quantifying demand by users for particular content, and then prompting contributors for additional items of the particular content. Narin is directed to an electronic shopping service providing access to a limited set of online retailers. Thomas is directed to online monitoring of search engine results to identify content that violates intellectual property rights. Kurauchi is directed to a system for inserting commercials into pay broadcast programs. Han is directed to a system for maintaining a database of URLs. Barzilai is directed to a system for establishing and enforcing privacy preferences. Skinner is directed to a web ranking bidding system. Applicants submit that each of the applied references are clearly in different fields, solving different problems, with different solutions. Combining these references together as set forth in the Office action is improper.

#### **I. Rejection of Claims 7, 14, and 16-20 under 35 U.S.C. 112**

Claims 7, 14, and 16-20 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants disagree, and direct the Examiner to the only full paragraph on page 14. To advance prosecution, however, Applicants have amended claims 7, 16, and

19 to conform more closely to the specification by reciting that the host modifies the titles of the links. Applicants submit that the rejection of claims 7, 16, and 19 under 35 U.S.C. 112 be removed. Claims 14, 17, 18, and 20 have been canceled.

## **II. Rejection of Claim 5 Under 35 U.S.C. 103(a)**

Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publ. No. 2004/0024656 to Coleman ("Coleman") in view of U.S. Patent No. 6,769,010 to Knapp et al. ("Knapp") in view of U.S. Patent Publ. No. 2002/0046045 to Narin et al. ("Narin") in view of U.S. Patent No. 6,401,118 to Thomas ("Thomas"). Applicants disagree. For example, none of the cited references can be reasonably interpreted to disclose an Integrated Web Ring such as disclosed in the specification of the present application. In addition, none of the cited references can be reasonably interpreted to disclose obtaining agreement from the candidate retail partner where the agreement includes providing searchable, sortable product information relative to at least one of price and manufacturer identity.

In addition, combining Narin with Thomas creates a combination that renders Thomas unfit for its intended purpose, as described above. Accordingly, Applicants submit that it is improper to combine Narin with Thomas, and thus submit that the rejection of claim 5 should be removed.

Further, Applicants submit that the Examiner has relied on improper hindsight to pick and choose these four (4) references to reject claim 5, as described above. Accordingly, Applicants request that the Examiner clearly identify a rational underpinning to the obviousness rejection of claim 5 that links all four of the references, or remove the rejection of claim 5.

For at least these reasons, Applicants submit that claim 5 is allowable for at least these reasons, and request that the rejection of claim 5 under 35 U.S.C. 103(a) be removed.

**II. Rejection of Claim 1, 7, 8, 10-14, and 16-20 Under 35 U.S.C. 103(a)**

Claims 1, 7, 8, 10-14, and 16-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publ. No. 2004/0107137 to Skinner ("Skinner") in view of U.S. Patent Publ. No. 2002/0046045 to Narin et al. ("Narin") in view of U.S. Patent No. 6,401,118 to Thomas ("Thomas"). Applicants disagree, and submit that the cited references, alone or in combination, fail to teach or suggest each and every limitation of the rejected claims. For example, the cited art fails to teach an Integrated Web Ring such as claimed in claims 1, 7, and 19 and disclosed in the specification of the present application, and fails to teach non-commercial content including information other than simple links, short descriptions of links, banner ads, promotional graphics, or short sentences.

In any event, Applicants submit that the portions of Skinner relied upon by the Examiner to reject claims 1, 7, 8, 10-14, and 16-20 have a priority date after the filing date of the present application, as described above. As such, the rejection of claims 1, 7, 8, 10-14, and 16-20 is improper. Applicants request that the Examiner remove the rejection of claims 1, 7, 8, 10-13, 16, and 19. Claims 14, 17, 18, and 20 have been canceled.

In addition, the combination of Narin with Thomas renders Thomas unfit for its intended purpose, as described above. Accordingly, Applicants submit that it is improper to combine Narin with Thomas, and thus submit that the rejection of claims 1, 7, 8, 10-13, 16, and 19 should be removed for at least this reason.

Further, Applicants submit that the Examiner has relied on improper hindsight to pick and choose these three (3) references to reject the claims, as described above. Accordingly,

Applicants request that the Examiner clearly identify a rational underpinning to the obviousness rejection of these claims that links all three of the references, or remove the rejection of these claims.

For at least these reasons, Applicants submit that claims 1, 7, 8, 10-13, 16, and 19 are in condition for allowance.

### **III. Rejection of Claim 2 Under 35 U.S.C. 103(a)**

Claim 2 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publ. No. 2004/0107137 to Skinner ("Skinner") in view of U.S. Patent Publ. No. 2002/0046045 to Narin et al. ("Narin") in view of U.S. Patent No. 6,401,118 to Thomas ("Thomas") in view of U.S. Patent Publ. No. 2002/0055854 to Kurauchi et al. ("Kurauchi"). Applicants disagree, and submit that the cited references, alone or in combination, fail to teach or suggest each and every limitation of claim 2. To the extent that the subject matter of claim 2 is similar to the subject matter of claim 1, Applicants submit that claim 2 is patentable for at least the same reasons that claim 1 is patentable.

In any event, Applicants submit that the portions of Skinner relied upon by the Examiner to reject claim 2 have a priority date after the filing date of the present application, as described above. As such, the rejection of claim 2 is improper. Applicants request that the Examiner remove the rejection of claim 2 for at least this reason.

In addition, the combination of Narin with Thomas renders Thomas unfit for its intended purpose, as described above. Accordingly, Applicants submit that it is improper to combine Narin with Thomas, and thus submit that the rejection of claim 2 should be removed.

Further, Applicants submit that the Examiner has relied on improper hindsight to pick and choose these four (4) references

to reject these claims, as described above. Accordingly, Applicants request that the Examiner clearly identify a rational underpinning to the obviousness rejection of these claims that links all four of the references, or remove the rejection of these claims.

For at least these reasons, Applicants submit that claim 2 is in condition for allowance.

#### **IV. Rejection of Claim 4 Under 35 U.S.C. 103(a)**

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publ. No. 2004/0107137 to Skinner ("Skinner") in view of U.S. Patent Publ. No. 2002/0046045 to Narin et al. ("Narin") in view of U.S. Patent No. 6,401,118 to Thomas ("Thomas") in view of U.S. Patent Publ. No. 2002/0055854 to Kurauchi et al. ("Kurauchi") in view of U.S. Patent Publ. No. 2001/0044800 to Han ("Han"). Applicants disagree. Claim 4 depends from and further limits claim 2, and is allowable for at least the same reasons that claim 2 is allowable. Applicants request that the rejection of claim 4 be removed.

In any event, Applicants submit that the portions of Skinner relied upon by the Examiner to reject claim 4 have a priority date after the filing date of the present application, as described above. As such, the rejection of claim 4 is improper. Applicants request that the Examiner remove the rejection of claim 4 for at least this reason.

In addition, the combination of Narin with Thomas renders Thomas unfit for its intended purpose, as described above. Accordingly, Applicants submit that it is improper to combine Narin with Thomas, and thus submit that the rejection of claim 4 should be removed.

Further, Applicants submit that the Examiner has relied on improper hindsight to pick and choose these five (5) references to reject claim 4, as described above. Accordingly, Applicants



request that the Examiner clearly identify a rational underpinning to the obviousness rejection of claim 4 that links all five of the references, or remove the rejection of claim 4.

For at least these reasons, Applicants submit that claim 2 is in condition for allowance.

**V. Rejection of Claim 9 Under 35 U.S.C. 103(a)**

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publ. No. 2004/0107137 to Skinner ("Skinner") in view of U.S. Patent Publ. No. 2002/0046045 to Narin et al. ("Narin") in view of U.S. Patent No. 6,401,118 to Thomas ("Thomas") in view of U.S. Patent No. 6,769,010 to Knapp et al. ("Knapp"). Applicants disagree. Claim 9 depends from and further limits claim 7, and is allowable for at least the same reasons that claim 7 is allowable. Applicants request that the rejection of claim 9 be removed.

In any event, Applicants submit that the portions of Skinner relied upon by the Examiner to reject claim 9 have a priority date after the filing date of the present application, as described above. As such, the rejection of claim 9 is improper. Applicants request that the Examiner remove the rejection of claim 9 for at least this reason.

In addition, the combination of Narin with Thomas renders Thomas unfit for its intended purpose, as described above. Accordingly, Applicants submit that it is improper to combine Narin with Thomas, and thus submit that the rejection of claim 9 should be removed.

Further, Applicants submit that the Examiner has relied on improper hindsight to pick and choose these four (4) references to reject claim 9, as described above. Accordingly, Applicants request that the Examiner clearly identify a rational underpinning to the obviousness rejection of claim 9 that links all four of the references, or remove the rejection of claim 9.

For at least these reasons, Applicants submit that claim 9 is in condition for allowance.

**VI. Rejection of Claim 6 Under 35 U.S.C. 103(a)**

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publ. No. 2004/0024656 to Coleman ("Coleman") in view of U.S. Patent No. 6,769,010 to Knapp et al. ("Knapp") in view of U.S. Patent Publ. No. 2002/0046045 to Narin et al. ("Narin") in view of U.S. Patent No. 6,401,118 to Thomas ("Thomas") in view of U.S. Patent Publ. No. 2002/0029201 to Barzilai et al. ("Barzilai"). Applicants disagree. Claim 6 depends from and further limits claim 5, and is allowable for at least the same reasons that claim 5 is allowable. Applicants request that the rejection of claim 6 be removed.

In addition, the combination of Narin with Thomas renders Thomas unfit for its intended purpose, as described above. Accordingly, Applicants submit that it is improper to combine Narin with Thomas, and thus submit that the rejection of claim 6 should be removed.

Further, Applicants submit that the Examiner has relied on improper hindsight to pick and choose these five (5) references to reject claim 6, as described above. Accordingly, Applicants request that the Examiner clearly identify a rational underpinning to the obviousness rejection of claim 6 that links all five of the references, or remove the rejection of claim 6.

For at least these reasons, Applicants submit that claim 6 is in condition for allowance.

**Conclusion**

Applicants submit that the claims are allowable for at least the reasons set forth herein. Applicants thus respectfully submit that claims 1, 2, 4-13, 16, and 19 as

presented are in condition for allowance and respectfully request favorable reconsideration of this application.

Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited aspects of the invention. The fact that Applicants may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicants' agreement therewith.

The Commissioner is hereby authorized to charge a one-month extension of time fee along with any deficiency or overpayment of any required fee during the entire pendency of this application to Deposit Account No. 12-384.

Respectfully submitted,

/James J. Barta, Jr./

James J. Barta, Jr., Reg. No. 47,409  
ARMSTRONG TEASDALE  
One Metropolitan Square, 26th Floor  
St. Louis, Missouri 63102  
(314) 621-5070

JJB/tmg  
Via EFS